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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/738,022
Filing Date	December 15, 2000
First Named Inventor	Lisa Marie Thomasco
Art Unit	1624
Examiner Name	Emily B. Bernhardt
Attorney Docket Number	PHRM0027-101/00159

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NOV 10 2003
TECH CENTER 1600/2900

Total Number of Pages in This Submission

ENCLOSURES (check all that apply)

- ☐ Fee Transmittal Form
 - ☐ Fee Attached
- ☐ Amendment / Reply
 - ☐ After Final
 - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement

- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☒ Petition
 - ☐ Petition to Convert to a Provisional Application
 - ☐ Power of Attorney, Revocation Change of Correspondence Address
 - ☐ Terminal Disclaimer
 - ☐ Request for Refund
 - ☐ CD, Number of CD(s)

- ☐ After Allowance Communication to Group
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) (please identify below):
 1. Exhibit A - Restriction Requirement dtd 1/15/03
 2. Exhibit B- Amendment and response to the Restriction Requirement filed 1/31/03
 3. Exhibit C- Change of Correspondence Address
 4. Exhibit D- Transmittal form
 5. Exhibit E- Facsimile Cover Sheet
 6. Exhibit F- Confirmation of Facsimile sent to PTO on 1/31/03
 7. Exhibit G- Auto-Reply Transmission
 8. Exhibit H- Notice of Abandonment

- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
 - ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53

Remarks

The Director is authorized to:
1. Charge fee(s) any fee necessary 2. Credit any overpayments
3. Charge any additional fee(s) during the pendency of this application
To Deposit Account No.: 50-1275

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Paul K. Legaard/38,534
Signature	
Date	October 31, 2003

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	Paul K. Legaard/38,534		
Signature		Date	October 31, 2003



DOCKET NO.: PHRM0027-101/00159.US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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PATENT
TECH CENTER 1600/2900

Inventors: **Thomasco and Gadwood**

Serial No.: **09/738,022**

Group Art Unit: **1624**


Filed: **December 15, 2000**

Examiner: **E. Bernhardt**

Title: **Oxazolidinone Photoaffinity Probes**

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On 31 October 2003


Paul K. Legaard Reg. No. 38,534

Mail Stop Petition
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT
UNDER 37 CFR §1.181**

Applicants respectfully request that the Notice of Abandonment dated September 5, 2003 be withdrawn. No fee appears to be necessary. If a fee is deemed necessary, the present Petition is accompanied by the authorization to charge the Deposit Account the appropriate fee.

Statement of Facts Involved

1. The U.S. Patent and Trademark Office (PTO) mailed an Office Action on January 15, 2003 in which the Examiner restricted Applicants' claims into six groups (see Exhibit A, enclosed herewith).

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2. Applicants' undersigned representative filed via facsimile an "Amendment and Response to the Restriction Requirement" on January 31, 2003 (see Exhibit B, enclosed herewith).
3. Applicants' undersigned representative also filed via the same facsimile transmission a "Change of Correspondence Address Application" along with the "Amendment and Response to the Restriction Requirement" on January 31, 2003 (see Exhibit C, enclosed herewith).
4. A "Transmittal Form" listing both the Amendment and Change of Correspondence Address was also filed via the same facsimile transmission on January 31, 2003 (see Exhibit D, enclosed herewith).
5. Applicants' undersigned representative also included with the papers transmitted via facsimile on January 31, 2003 a facsimile cover sheet listing the "Transmittal Form", the "Change of Correspondence Address Application", and the "Amendment and Response to the Restriction Requirement" (see Exhibit E, enclosed herewith).
6. Applicants' undersigned representative encloses herewith a copy of the "Confirmation Report" which depicts the facsimile cover sheet and lists the status of the facsimile transmission as "OK" (see Exhibit F).
7. Applicants' undersigned representative also encloses herewith a copy of the "Auto-Reply Facsimile Transmission" which depicts the facsimile cover sheet and indicates that the 6 page transmission was received on "1/31/03 5:25:38PM [Eastern Standard Time]" (see Exhibit G).
8. The PTO mailed a Notice of Abandonment on September 15, 2003 (see Exhibit H, enclosed herewith).

Action Requested

Because the facts stated above clearly indicate that Applicants indeed responded in a timely manner to the PTO Office Action mailed January 15, 2003, Applicants respectfully request that the Notice of Abandonment dated September 5, 2003 be withdrawn.

Respectfully submitted,



Paul K. Legaard
Registration No. 38,534

Date: **31 October 2003**

COZEN O'CONNOR
1900 Market Street
Philadelphia, PA 19103-3508
Telephone: (215) 665-6914
Facsimile: (215) 701-2141



Exhibit A

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,022	12/15/2000	Lisa Marie Thomasco	00159PHRM284	9402

26657 7590 01/15/2003

WOODCOCK WASHBURN KURTZ MACKIEWICZ & NORRIS LLP
ATTENTION: SUZANNE E. MILLER ESQ.
ONE LIBERTY PLACE, 46TH FLOOR
PHILADELPHIA, PA 19103

PHRM0027-101

EXAMINER
BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
1624	9

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JAN 22 2003

DATE MAILED: 01/15/2003

Woodcock Washburn

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

NOV 03 2003

TRADEMARK OFFICE

Application No.
09/738,022

Applicant(s)
THOMASCO et al.

Examiner
Emily Bernhardt

Art Unit
1624

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-26 are subject to restriction and/or election requirement.

Applicant Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1624

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-6, drawn to azido-containing piperazine derivatives, classified in class 544, subclasses 367,369.
- II. Claims 7-12, drawn to azido biphenyl derivatives, classified in class 548, subclasses 231,243.
- III. Claims 13-17, drawn to pyridyl derivatives, classified in class 546, subclasses 271.4,272.1.
- IV. Claims 18-20, drawn to use employing compounds of I, classified in class 436, subclass 501,504 etc..
- V. Claims 21-23, drawn to use employing compounds of II , classified in class 436, subclass 501, 504 etc.
- VI. Claims 24-26, drawn to use employing compounds of III , classified in class 436, subclass 501,504 etc.

The inventions are distinct, each from the other because of the following reasons: Compounds of I-III are drawn to compounds of considerable structural dissimilarity in view of the varying rings present on phenylazole derivatives. Thus

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they are separately classified in the US patent classification system and require separate online searching for additional, potential non-US patent references. Each can support a patent as the compounds of each group are capable of being utilized alone not in combination with other members listed in the Markush group.

Inventions I-III and IV-VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case compounds embraced by I-~~VI~~^{III} have additional use as antimicrobial agents, particularly as antibacterials as taught by the instant disclosure and the prior art.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if

Art Unit: 1624

one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication should be directed to Emily Bernhardt at telephone number (703) 308-4714.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.



EMILY BERNHARDT

PRIMARY EXAMINER

GROUP 1600

Exhibit F

Confirmation Report - Memory Send

Date & Time: Jan-31-2003 05:26pm
Tel line : 215-665-2013
Machine ID : Cozen O'Connor

Job number : 606
Date & Time : Jan-31 05:24pm
To : 2286#130907#0#917038729306#
Number of pages : 006
Start time : Jan-31 05:24pm
End time : Jan-31 05:26pm
Pages sent : 006
Status : OK

Job number : 606 *** SEND SUCCESSFUL ***

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1900 MARKET STREET PHILADELPHIA, PA 19103-3508 215.665.2000 800.523.2900 215.665.2013 FAX www.cozen.com

FACSIMILE

Sender's Name: Paul K. Legaard Ser. No.: 09/738,022
Cozen Ref. No.: PHRM0027-101 (130907) Pages to Follow: 5
Date: January 31, 2003 OFFICIAL FAX

RECIPIENT(S)	COMPANY/FIRM	FAX
Examiner E. Bernhardt	USPTO	(703) 872-9306

MESSAGE: OFFICIAL FACSIMILE

PLEASE DELIVER TO EXAMINER E. BERNHARDT. ATTACHED IS:

1. Transmittal Form;
2. Change of Correspondence Address Application; and
3. Amendment and Response to the Restriction Requirement.

IF YOU DO NOT RECEIVE ALL PAGES, PLEASE CALL 215.665.2000 or 800.523.2900 IMMEDIATELY.
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TO:Auto-reply fax to 215 665 2013 COMPANY:

Auto-Reply Facsimile Transmission



UNITED STATES
PATENT AND
TRADEMARK OFFICE

TO:

Fax Sender at 215 665 2013

Fax Information

Date Received:

Total Pages:

1/31/03 5:25:38 PM [Eastern Standard Time]

6 (including cover page)

ADVISORY: This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMEP) section 306 et seq.

Received
Cover
Page

=====>

Jan-31-2003 05:24pm From-Cozen O'Connor 215-665-2013 T-606 P.001/006 F-606

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Sender's Name: Paul K. Legaard Ser. No.: 09/738,023

Cozen Ref. No.: PRRM0027-101 (130907)

Pages to Follow: 5

Date: January 31, 2003

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RECIPIENT(S)	COMPANY/FIRM	FAX
Examiner E. Bernhardt	USPTO	(703) 872-9306

MESSAGE: OFFICIAL FACSIMILE

PLEASE DELIVER TO EXAMINER E. BERNHARDT. ATTACHED IS:

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2. Change of Correspondence Address Application; and
3. Amendment and Response to the Restriction Requirement.

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Exhibit H

MD
PK

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,022	12/15/2000	Lisa Marie Thomasco	00159PHRM284	9402
26657	7590	09/05/2003	PHRM0027-101	
WOODCOCK WASHBURN KURTZ MACKIEWICZ & NORRIS LLP ATTENTION: SUZANNE E. MILLER ESQ. ONE LIBERTY PLACE, 46TH FLOOR PHILADELPHIA, PA 19103			EXAMINER BERNHARDT, EMILY B	

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SEP 09 2003

Woodcock Washburn

Please find below and/or attached an Office communication concerning this application or proceeding.

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COZEN IP DEPT.

SEP 11 2003

DUE DATE

MAX DATE

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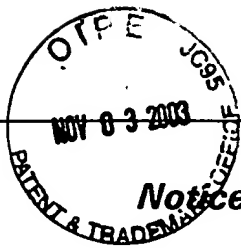
11/5/03

Signature

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Notice of Abandonment

TECH CENTER 1600/2900

Application No.

09/738,022

Applicant(s)

THOMASCO et al.

Examiner

Emily Bernhardt

Art Unit

1624



- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 1/15/03.

(a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.

(b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113(a) to the final rejection.

(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).

(c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).

(d) ☒ No reply has been received.

2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).

(a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).

(b) ☐ The submitted issue fee of \$ _____ is insufficient. A balance of \$ _____ is due.

The issue fee required by 37 CFR 1.18 is \$ _____. The publication fee, if required by 37 CFR 1.18(d) is \$ _____

(c) ☐ The issue fee and publication fee, if applicable, has not been received.

3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).

(a) ☐ Proposed new formal drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.

(b) ☐ No corrected drawings have been received.

4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.

6. ☐ The decision by the Board of Patent Appeals and Interferences rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

7. ☒ The reason(s) below:

The examiner was informed by the Docketing Dept. of Woodcock Washburn, notably Ms. Janet Griffin on 9/3/03, that instant case is no longer being handled by this law firm. However, as no revocation of power of attorney papers is seen in the file and the statutory period to respond to the action mailed 1/15/03 has passed, a Notice of Abandonment will be sent to Woodcock Washburn.

E Bernhardt
EMILY BERNHARDT
PRIMARY EXAMINER
ART UNIT 1624

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

- (4) A claim being canceled must be listed in the claim listing with the status identifier "canceled"; the text of the claim must not be present. Providing an instruction to cancel is optional.
- (5) Any claims added by amendment must be presented in the claim listing with the status identifier "(new)"; the text of the claim must not be underlined.
- (6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled, or not entered, claims may be aggregated into one statement (e.g., Claims 1 - 5 (canceled)).

Example of listing of claims (use of the word "claim" before the claim number is optional):

- Claims 1-5 (canceled)
- Claim 6 (previously presented): A bucket with a handle.
- Claim 7 (withdrawn): A handle comprising an elongated wire.
- Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.
- Claim 9 (currently amended): A bucket with a ~~green~~ blue handle.
- Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.
- Claim 11 (canceled)
- Claim 12 (not entered)
- Claim 13 (new): A bucket with plastic sides and bottom.

B) Amendments to the specification:

Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125.

The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 1 as number 14 as)

C) Amendments to drawing figures:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. Any marked-up (annotated) copy showing changes must be labeled "Annotated Marked-up Drawings" and accompany the replacement sheet in the amendment (e.g., as an appendix). The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, or Joe Narcavage, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to patentpractice@uspto.gov or by phone at (703) 305-1616.